

### **REMARKS**

Claims 1-6 and 8-17 are pending. No new matter has been added by way of the present submission. For instance, claim 1 has been amended to indicate that the silver salt of an organic acid is a silver salt of a long-chained aliphatic carboxylic acid having 15-28 carbon atoms. Support for this amendment may be found in the present specification at page 79, lines 1-4. Claim 1 has also been amended to indicate that the reducing agent is a bisphenol reducing agent as supported by the present specification at page 89, lines 9-13 and 17-18. Lastly, new claim 16 is supported by the present specification at page 79, lines 13-14 and new claim 17 is supported by the present specification at page 89, lines 9-13. Accordingly, no new matter has been added.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

#### **Issues under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 1-6 and 8-15 under 35 U.S.C. § 103(a) as being obvious over Ito '084 in view of JP '136 or Adin. Applicants respectfully traverse this rejection.

Applicants herein incorporate all previously submitted arguments of record. This includes incorporation of all arguments as they relate to the Declarations under 37 CFR §1.132. Each of these arguments is preserved should an appeal become necessary.

In the Advisory Action dated July 19, 2007, the Examiner indicated that the Declaration filed on June 29, 2007 was not sufficient since the silver behenate and the bisphenol reducing agent used are the most preferred in the art. However, the present claims have now been amended to be commensurate in scope with these results. For instance, the silver salt of the organic acid now recites a silver salt of a long-chained aliphatic carboxylic acid having 15-28

carbon atoms (note that silver behenate is a 22 carbon compound within this most preferred group). Also, the reducing agent has been amended to refer to the preferred bisphenol reducing agent. As such, the present claims have been restricted to the most preferred combination of elements. The less preferred embodiments have now been excluded and thus no additional testing is required.

Applicants remind the Examiner that the comparative showing need not compare the claimed invention with all of the cited prior art, In re Fenn et al., 208 USPQ 470 (CCPA 1981), but only with the closest prior art. In re Holladay, 199 USPQ 516 (CCPA 1978); see also In re Merchant, 197 USPQ 785 (CCPA 1978); see also In re Wood et al., 202 USPQ 171 (CCPA 1979). In the case of chemical compounds, this means only the compound or compounds closest structurally thereto must be tested. In re Kuderna, 165 USPQ 575 (CCPA 1970). In fact, Applicant is permitted to test compounds which are even more closely related than those of the prior art. Ex parte Humber, 217 USPQ 265 (POBA 1981).

In the present instance, the closest example of Ito '084 was replicated using the material and methods of Ito '084. Then, a comparison with the present invention was made by simple addition of compound 95 of JP '136. No additional changes were made. This is true for each of the comparisons presented in the original Yamaguchi Declaration as well as the more current Declaration filed on June 29, 2007. Legally, once unexpectedly superior results are shown under these circumstances, the *prima facie* of obviousness must fall. Thus, additional experimentation for other aspects of the present invention, which are further removed from that of the comparison, need not be performed.

In summary, Applicants submit that it is evident that the present invention achieves unexpectedly superior results compared to the cited art. Accordingly, any hypothetical *prima facie* case of obviousness, which Applicants disagree on the existence thereof, is therefore moot. The Examiner is thus requested to withdraw this rejection.

#### Obviousness-Type Double Patenting

The Examiner has rejected claims 1-6 and 7-15 (note that claim 7 has been canceled) under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-20 of U.S. Patent No. 6,764,816 (Ohzeki) in view of Ito '084. Applicants respectfully traverse this rejection.

As shown above, the present invention achieves unexpectedly superior results compared the cited art. Thus, this rejection is overcome for the same reasons. Additionally, Applicants point out that it is not obvious from claims 1-20 of U.S. Patent No. 6,764,816 that the combination of the claimed two types of compounds achieves the synergetic improvements of sensitivity and reduction of Dmin after leaving. Thus, this rejection is improper and should be withdrawn.

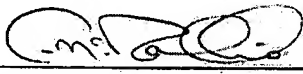
In view of the above, Applicants respectfully submit that the present application is in condition for allowance. The Examiner is therefore respectfully requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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